

### REMARKS

This is in response to the Office Action mailed on August 16, 2004, and the references cited therewith.

No claims are amended, no claims are canceled, and no claims are added; as a result, claims 1-7, 9-18, and 20-39 are now pending in this application.

#### §102 Rejection of the Claims

Claims 1-7, 9-17 and 20-24 were rejected under 35 USC § 102(e) as being anticipated by Kohn et al. (U.S. Patent No. 5,963,447; hereinafter referred to as Kohn). Applicant traverses this rejection because Kohn does not anticipate claims 1-7, 9-17 and 20-24.

Anticipation requires the disclosure, in a single prior art reference, of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Regarding independent claim 1, the Office Action asserts that Kohn anticipates the claimed “annotating one or more actions of a sequence of actions in the production recipe with a desired intention for the one or more actions.” In particular, the Office Action asserts that Kohn’s “recipe for building a procedural model (automaton) for generating a variable instantiation and theorem proving” (Kohn Column 21, Lines 40-44) anticipates the claimed “production recipe.” However, the claimed “production recipe” includes “one or more actions of a sequence of actions.” Applicant cannot find, and the Office Action does not point to, any passage in Kohn that teaches the claimed production recipe including “one or more actions of a sequence of actions.” As such, Applicant respectfully submits that Kohn’s “recipe for building a procedural model” does not anticipate the claimed “production recipe.”

Since Kohn's recipe does not include the claimed "one or more actions of a sequence of actions," Kohn certainly does not teach the claimed "annotating one or more actions of a sequence of actions in the production recipe with a desired intention for the one or more actions." (Emphasis added.). Furthermore, the Office Action does not point to a passage in Kohn that teaches these claim features.

Regarding assertions appearing in the Office Action mailed July 24, 2003 (referred to hereinafter as Paper Number 16), Paper Number 16 asserts that Kohn's "behavior statement" conveys the claimed "desired intention." However, neither Paper 16 nor the most recent Office Action points to a passage in Kohn that teaches using Kohn's "behavior statement" for "annotating one or more actions of a sequence of actions" as recited in the rejected claim.

Referring back to the most recent Office Action, Applicant also cannot find a passage in Kohn that teaches the claimed "wherein the production recipe is for producing a quantity of a product." The Office Action points to Kohn's "Products" (Kohn Column 21, Lines 40-44) as being the claimed "quantity of a product." However, Applicant cannot find a passage in Kohn that indicates Kohn's "recipe for building a procedural model" is a recipe for producing a quantity of products. As such, Applicant respectfully submits that Kohn does not teach the claimed "production recipe for producing a quantity of product."

Independent claims 3, 6, 9, and 23 each include features similar to those noted in the discussion of independent claim 1. For at least the reasons discussed above, Applicant respectfully submits that independent claims 1, 3, 6, 9 and 23 are allowable.

Claims 2, 4, 5, 7, 10-17, 20-22, 24, and 37-39 each depend, directly or indirectly, on one of independent claims 1, 3, 6, 9 or 23 and are allowable for at least the reasons discussed above.

For at least the reasons cited above and elements of the claims, Applicant respectfully submits that Kohn does not teach or suggest each and every element of claims 1-7, 9-17, 20-24, and 37-39. Therefore, Applicant requests that the rejections be withdrawn and the claims be allowed.

### §103 Rejection of the Claims

Claim 18 was rejected under 35 USC § 103(a) as being unpatentable over Kohn et al. in view of Acknowledged Prior Art (U.S. Patent No. 5,963,447, referred to as Kohn; Specification,

referred to as Acknowledged Prior Art, APA). Applicant traverses this rejection because the Office Action has not made a *prima facie* case of obviousness.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.*

The *Fine* court stated that:

Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* (emphasis in original).

The M.P.E.P. adopts this line of reasoning, stating that

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Claim 18 depends on independent claim 9. As discussed above, Applicant submits that Kohn does not teach or suggest all of the elements of claim 9. APA does not provide what Kohn

is lacking. Therefore, Applicant respectfully submits that, for at least the reasons noted above, the combination of Kohn and APA does not teach or suggest each and every element of dependent claim 18.

Allowable Subject Matter

Claims 25-36 were indicated to be allowable. Applicant acknowledges and thanks the Examiner for indicating claims 25-36 are allowable.

Reservation of Rights

Applicant does not admit that documents cited under 35 U.S.C. §§ 102(a), 102(e), 103/102(a), or 103/102(e) are prior art, and reserves the right to swear behind them at a later date. Arguments presented to distinguish such documents should not be construed as admissions that the documents are prior art.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 612-371-2169 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 18 day of October, 2004.

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Signature